

Application No.: 10/773,912
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/773,912 Confirmation No. : 7385
Applicant : Constantine A. DOMASHNEV
Filed : February 6, 2004
Title : **Electronic Prescription Handling System**
Group Art Unit : 3626
Examiner : Neal R. SEREBOFF
Customer No. : 28289

MAIL STOP APPEAL BRIEF – PATENTS

Commissioner for Patents
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APPELLANT'S BRIEF UNDER 37 C.F.R. § 41.37

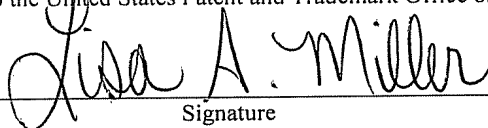
Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed November 13, 2008. The mailing date of the Notice of Panel Decision from Pre-Appeal Brief Review is dated December 19, 2008. The USPTO was closed on January 19-20, 2009. Accordingly, this Appeal Brief is timely filed without any extension fees on January 21, 2009.

The headings used hereinafter and that which is set forth under each heading are in accordance with 37 C.F.R. § 41.37(c)(1).

I hereby certify that this correspondence is being electronically submitted to the United States Patent and Trademark Office on January 21, 2009.

01/21/2009
Date


Signature

Lisa A. Miller

Typed Name of Person Signing Certificate

I. REAL PARTY IN INTEREST

The real party in interest for the application in this Appeal is the applicant, Constantine Domashnev, of the pending application (hereinafter, "Appellant").

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellant or Appellant's legal representative, which will directly affect, or be directly affected by or having a bearing on, a decision in the present Appeal.

III. STATUS OF CLAIMS

Claims 1-22 are pending in the present application and have all been finally rejected. Only claims 1, 10, 11, 13, and 17 are the subject of this Appeal. Claims 1 and 13 stand finally rejected under 35 U.S.C. § 103(a) for obviousness over U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of U.S. Patent Application Publication No. 2003/0195838 to Henley (hereinafter "Henley I"). Claims 10 and 11 stand finally rejected under 35 U.S.C. § 103(a) for obviousness over U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of U.S. Patent Application Publication No. 2003/0195838 to Henley I, further in view of U.S. Patent Application Publication No. 2003/0154376 to Hwangbo, and further in view of U.S. Patent Application Publication No. 2002/0035484 to McCormick. Claim 17 stands finally rejected under 35 U.S.C. § 103(a) for obviousness over U.S. Patent Application Publication No. 2002/0065758 to Henley (hereinafter "Henley II") in view of U.S. Patent Application Publication No. 2001/0039503 to Chan et al. and U.S. Patent Application Publication No. 2005/0039032 to Babowicz et al.

IV. STATUS OF AMENDMENTS

No amendments have been made to the claims after the Final Office Action dated September 30, 2008. Section VIII, below, lists the currently pending claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Generally, the present invention is directed to a system and method for providing a lower cost prescription to a patient by inviting bids for the prescription and

generating a prescription from an Internet-connected computer. The invention is also directed to an electronic prescription handling system including an application reside on a portable storage medium and configured to transmit a digital certificate upon interface of the portable storage medium with a computer, whereby an authenticating server then transmits a prescription entry web page to the computer for prescription entry and processing.

For purposes of this Appeal, Appellant's representative invention is set forth as a system and method in claims 1, 10, 11, 13, and 17. Reference to the underlying support for each of these claims is made with respect to the corresponding published application, U.S. 2005/0177392.

Independent claim 1 recites an electronic prescription handling system (*See*, generally, Paragraph [0013]; FIG. 1) including (a) a first computer configured to transmit a prescription by a physician (*See* Paragraph [0028], lines 1-7); (b) a server communicatively connected to the first computer and functionally distinct therefrom (*See* Paragraph [0027], lines 1-4; FIG. 1), wherein the server is configured to receive the prescription from the first computer (*See* Paragraph [0013], lines 5-7), wherein the server is remote from the first computer and is operated by a service provider (*See* Paragraph [0027], lines 7-10); (c) a first pharmacy having a first pharmacy computer communicatively connected to the server (*See* Paragraph [0026], lines 8-11), wherein the first pharmacy computer is configured to: retrieve the prescription from the server; and transmit a first bid for the prescription to the server, wherein the first bid is stored on the server (*See* Paragraph [0034], lines 8-13); (d) a second pharmacy having a second pharmacy computer communicatively connected to the server (*See* Paragraph [0026], lines 8-11), wherein: the second pharmacy computer is configured to: retrieve the prescription from the server; and transmit a second bid for the prescription to the server, wherein the second bid is stored on the server (*See* Paragraph [0034], lines 8-13); and (e) a second computer communicatively connected to the server, wherein the second computer is operated by a patient and is configured to: retrieve the first bid and the second bid (*See* Paragraph [0030], lines 1-12); and select one of (i) the first bid, and (ii) the second bid (*See* Paragraph [0037], lines 1-4), such that when the first bid is selected, the first pharmacy fills the prescription, and when the second bid is selected, the second pharmacy fills the prescription (*See* Paragraph [0037], lines 10-18). The server is further configured to transmit at least one of (i) an address of the first pharmacy or second pharmacy (*See* Paragraph [0036], lines 25-27), and (ii) a set of directions from the first pharmacy or second

pharmacy to an address specified by the second¹ computer (*See* Paragraph [0036], lines 32-34). The server is also configured to transmit a map illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy (*See* Paragraph [0036], lines 32-34).

A method for issuing a prescription includes the steps of: transmitting a prescription from a first computer by a physician (*See* Paragraph [0028], lines 1-7); receiving the prescription on a server (*See* Paragraph [0013], lines 5-7) functionally distinct from the first computer (*See* Paragraph [0027], lines 1-4; FIG. 1), wherein the server is remote from the first computer and is operated by a service provider (*See* Paragraph [0027], lines 7-10); retrieving the prescription from the server; submitting a first bid for the prescription to the server from a first pharmacy having a first pharmacy computer (*See* Paragraph [0034], lines 8-13); submitting a second bid for the prescription to the server from a second pharmacy having a second pharmacy computer; storing the first bid and the second bid on the server (*See* Paragraph [0034], lines 8-13); transmitting the first bid and the second bid to a second computer operated by a patient (*See* Paragraph [0030], lines 1-12); viewing the first bid and the second bid on the second computer; making a selection consisting of one of (i) the first bid, and (ii) the second bid (*See* Paragraph [0037], lines 1-4); transmitting the selection to the server; and informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the prescription (*See* Paragraph [0037], lines 10-18).

An electronic prescription handling system includes a computer; a server communicatively connected to the computer (*See* Paragraph [0027], lines 1-4; FIG. 1); a portable storage medium configured to interface with the computer (*See* Paragraph [0028], lines 7-10; FIG. 2); an application residing on the portable storage medium, wherein the computer is configured to automatically execute the application once the portable storage medium interfaces with the computer (*See* Paragraph [0027], lines 19-23), wherein the application includes a file associated therewith for instructing the computer to execute the application, further wherein the application is configured to transmit a digital certificate to the server upon the application sensing a network connection to the server; and means for authenticating the digital certificate on the server (*See* Paragraph [0027], lines 28-35; Paragraph [0031], lines 14-16), wherein when the digital certificate is positively authenticated (*See* Paragraph [0031], lines 17-20), the server transmits a prescription entry web page to the computer (*See* Paragraph [0032], lines 1-7), further wherein a user of the

computer enters a prescription into the prescription entry web page (*See* Paragraph [0033]), and thereafter the computer transmits the prescription to the server (*See* Paragraph [0034], lines 1-3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(a) *Are claims 1 and 13 obvious under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of U.S. Patent Application Publication No. 2003/0195838 to Henley I?*

(b) *Are claims 10 and 11 obvious under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of U.S. Patent Application Publication No. 2003/0195838 to Henley I, further in view of U.S. Patent Application Publication No. 2003/0154376 to Hwangbo, and further in view of U.S. Patent Application Publication No. 2002/0035484 to McCormick?*

(c) *Is claim 17 obvious under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2002/0065758 to Henley II in view of U.S. Patent Application Publication No. 2001/0039503 to Chan and U.S. Patent Application Publication No. 2005/0039032 to Babowicz et al.*

VII. ARGUMENT

Claims 1 and 13

The Examiner has failed to establish a prima facie case of obviousness of claim 1 and 13 based upon the disclosure, teaching, or suggestion of the Munoz and Henley I publications.

The Final Office Action dated September 30, 2008 fails to identify a reason apparent to a person having ordinary skill in the art of ASP medical-based computing implementations for making the combination of the teachings of the Munoz publication with those of the Henley I publication to obtain the limitations of independent claims 1 and 13, resulting in a clear deficiency in establishing a *prima facie* case of obviousness in support of the rejection of claims 1 and 13.

The Examiner asserts that Appellant's argument that the claimed first computer and server are separate entities is simply a matter of design choice and should therefore not be considered to be a patentable distinction. However, the design choice rule of law does not apply to the instant case because Appellant has set forth relationship-defining limitations that have structural and operational differences attributed thereto. Specifically,

claims 1 and 13 describe how the first computer is functionally distinct from the first computer and how the first computer is operated by a physician, whereas the server is operated by a service provider. The novelty of the present invention, among other things, is that the service provider would review the incoming bids, as opposed to having the bids come in to the computer operated by the physician. Therefore, it would not make sense to have the service provider work on the same computer as that of the physician. Otherwise, the service provider would need to visit every single physician's computer, which defeats the purpose of the service provider implementation of the claimed invention.

Appellant has previously submitted a Declaration Under 37 C.F.R. § 1.132 (Attached as Appendix A; hereinafter referred to as "the Declaration") signed by the Inventor, Mr. Constantine Domashnev, as well as an exemplary survey mailing (Attached as Appendix B; hereinafter referred to as "the Survey Card") outlining the questions posed in a survey conducted by Mr. Domashnev. The Examiner has dismissed the merits of the Declaration, even though Mr. Domashnev has set forth in his Declaration the rationale for why neither the Munoz nor Henley I publication contains any suggestion or motivation to combine the teachings of these references. Specifically, in §3(a) of his *Declaration*, Mr. Domashnev declares:

The deficiency of the system disclosed in the Munoz publication, among other things, lies in the fact that physicians are charged with the task of collecting, reviewing, and forwarding the bids to the patient, in paper form, nonetheless. In practice, the physicians will not have time to review all the bids and the workload will be increased for them. This, in effect, increases the cost of the prescription (i.e., increased overhead costs need to be passed on to the patient), which is opposite to the intended goal of the present invention. The service provider of the present invention undertakes this aforementioned increased overhead. Specifically, the patient is allowed to view and select from the offered bids via their own computer. The physician's duties therefore only extend to submission of the prescription, which is no different or incurs greater effort and resources, than is currently employed by a physician. It is more effective to allow the patient to view and select from the various bids because multiple criteria is to be taken into account. The patient's decision will be based, among other things, on geographic location, proximity to commuting routes, immediate availability, discount cards with some specific pharmacies, etc. It is not a single criteria choice (i.e., cost), as discussed in the Munoz publication. For example, if the cost of the medication was the only criteria, all patients would drive to Canada for their prescriptions. However, the cost of gas and time budgeting are part of the equation, as well.

Accordingly, Mr. Domashnev does not view the Munoz publication to contain any suggestion or motivation for one skilled in the art of ASP medical-based computing implementations to utilize the teachings of the Munoz publication in the context of an electronic prescription handling system according to the claimed invention.

Contrary to the Examiner's assertions, the previously submitted Declaration does in fact relate to the individual claims of the application. The survey questions posed to the physicians, via the Survey Card, directly relate to the invention because it is the answer to the questions that go toward addressing the long-felt need aspect of the claimed system. Specifically, Question 1 addresses the automation aspect embodied in claims 1 and 13 by virtue of it being implemented via computers and Question 5 addresses the auction aspect provided by the system allowing two or more pharmacy computers to retrieve the prescription from the service provider's server for purposes of bidding on the prescription, as set forth in claims 1 and 13. Therefore, Appellant does not understand how the Examiner can reasonably assert that the Declaration, incorporating the survey, as set forth in §2 of the Declaration, does not sufficiently address the specific claims.

The Examiner asserts that Appellant is simply making a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. However, Appellant has already done this in the context of addressing previous anticipation rejections. Faced with the obviousness rejections in the most recent Office Actions, Appellant has addressed why it would not be obvious to combine the prior art references as set forth by the Examiner. Therefore, Appellant does not understand the Examiner's contention in this regard.

The Examiner asserts that use of the term "service provider" for purposes of distinguishing the claimed invention from the prior art represents an intended use of the claimed server. However, the term "service provider", as is known in the art, is an entity that provides a service. With respect to the present invention, the service provider acts as an intermediary to offload the involved task of a physician collecting, reviewing, and forwarding bids to a patient. The term "service provider" therefore, at least with respect to the method claim 13, cannot be viewed as purely an intended use limitation, as the requirement that the server be operated by the service provider is a recitation of a positive step in the method, as with any of the other steps.

The Examiner initially rejected Appellant's "reverse auction" argument on the

basis that Appellant has failed to explicitly claim this feature. However, Appellant has previously indicated that this feature is inherent in the claimed steps of the invention and, therefore, there is no reason to refer to the concept by name, regardless of whether or not a reverse auction is occurring. The Examiner was respectfully requested to examine the merits of the claims based upon the wording selected by Appellant. The Examiner then submitted that a "reverse auction" has various meanings, as shown in the cited "Dutch auction article" attached to the final Office Action dated September 30, 2008. However, this article only defines a Dutch auction as being the "reverse of the traditional auction model in which an auctioneer starts off with a high price..." It appears to Appellant that the Examiner simply sees the word "reverse" in the definition and, therefore, incorrectly, equates the Dutch auction with the term of art "reverse auction." This has no bearing on Appellant's choice to not explicitly claim a reverse auction. The Examiner then cites U.S. Patent Application Publication No. 2005/0065821 to Kalies for the purpose of showing the disclosure of reverse auction as it relates to pharmacy prescription bidding. However, first, the Examiner has not formally rejected the claims using this reference, and second, doing so at that point in the prosecution would clearly be indicative of the Examiner making an improper hindsight rejection in combining the teachings of prior art references by using the claimed invention as a template. Such hindsight reconstruction is impermissible (*Texas Instruments Inc. v. U.S. Intern. Trade Com'n.*, 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993)).

In §3(b) of his *Declaration*, Mr. Domashnev declares:

In the Henley publication, there is a disclosure with respect to "registered buyers" (e.g., patients) who have the ability to log-in to a computer system using their own computer for purposes of buying prescriptions at offered prices set forth by vendors. However, this disclosure in the Henley publication is akin to a traditional auction, as opposed to the reverse auction of the present invention. This assertion is supported by the fact that "registered buyers" in the Henley system can outbid other "registered buyers". However, the present invention is more than just a reverse auction in that a user (i.e., the patient) of the service is provided with multiple choices and trade-offs with respect to formulating a decision as to which pharmacy to utilize in filling the prescription. For example, convenience of picking up the medication and availability of the medication are factors which may cause the user to select a more expensive bid. Neither the Munoz nor Henley publications, either alone or in combination, disclose, teach, or suggest an ASP-based electronic prescription handling system comprising an auction conducive to multi-objective prescription choices offered to a patient.

Accordingly, Mr. Domashnev does not view either the Munoz or Henley publications to contain any suggestion or motivation for one skilled in the art of ASP medical-based computing implementations to utilize the teachings of the Munoz or Henley publications in the context of an electronic prescription handling system according to the claimed invention.

Claims 10 and 11

The Examiner has failed to establish a prima facie case of obviousness of claim 10 and 11 based upon the disclosure, teaching, or suggestion of the Munoz, Henley I, Hwangbo, and McCormick publications.

The Final Office Action dated September 30, 2008 fails to identify a reason apparent to a person having ordinary skill in the art of ASP medical-based computing implementations for making the combination of the teachings of the Munoz, Henley I, Hwangbo, and McCormick publications to obtain the limitations of dependent claims 10 and 11, resulting in a clear deficiency in establishing a *prima facie* case of obviousness in support of the rejection of claims 10 and 11.

Appellant hereby incorporates by reference the aforementioned arguments made with respect to independent claim 1, above.

Claims 10 and 11 relate to directions and mapping of the pharmacies, which is beneficial to the patient in making informed decisions as to which pharmacy to select at the time of making a bid. As discussed in §3(b) of Mr. Domashnev's Declaration, "[t]he patient's decision will be based, among other things, on geographic location, proximity to commuting routes..." Thus, providing directions and mapping of pharmacies, among other things, is not a single criteria choice (e.g., cost), as discussed in the Munoz publication. Furthermore, the motivation for combination of the teachings of the prior art provided by the Examiner is improper as it relates to "eliminating inefficiencies at the doctor's office in generating the prescriptions". Appellant fails to understand how providing directions and maps would improve on generating prescriptions more efficiently. Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness with respect to claims 10 and 11.

Appellant acknowledges the Examiner's assertion of recent Supreme Court precedent in the *KSR* decision (*KSR v. Teleflex*, 550 U.S. ____ at 14, 127 S. Ct. 1727 (2007), citing *In re Kahn*, 441 F.3d 977 (Fed Cir. 2006)). However, the Examiner fails to expound on why he believes that the results of the combination of existing elements would be

predictable. Supreme Court precedent also requires that a rejection "on obviousness grounds cannot be sustained by mere conclusory statements," which Appellant believes is the case here. By virtue of Appellant's Declaration and arguments, Appellant had indicated how the prior art includes deficiencies, which would therefore not lend the teachings of the prior art to be combined. Additionally, Appellant had argued the advantages associated with the invention as set forth in claim 11. However, the Examiner completely fails to address the merits of the Declaration with respect to these issues. An Examiner must take into account secondary considerations offered in a Declaration in his obviousness analysis, which evidently, the Examiner has failed to do.

Claim 17

The Examiner has failed to establish a prima facie case of obviousness of claim 17 based upon the disclosure, teaching, or suggestion of the Henley II, Chan, and Babowicz publications.

The Examiner's motivation for combining the teaching of the Babowicz publication with that of the other references is illogical in the context of the claimed invention. Specifically, the Examiner states that the motivation would be to "provide local use of an authentication program running on the client, who reduces communications and processing demands of the server." However, the Auto-Run feature has nothing to do with reducing communications and processing demands, either in Babowicz or the claimed invention. In fact, the purpose of providing the Auto-Run feature in Appellant's invention is to automatically execute an application to transmit a digital certificate to the server. This action clearly does not reduce communications and processing demands regardless of whether the certificate were stored locally on a computer or on the portable medium.

The Examiner has dismissed the merits of the Declaration. Contrary to the Examiner's assertions, the previously submitted Declaration does in fact relate to the individual claims of the application. The survey questions posed to the physicians, via the Survey Card, directly relate to the invention because it is the answer to the questions that go toward addressing the long-felt need aspect of the claimed system. Specifically, Question 2 addresses the universal accessibility of the portable storage medium of claim 17. Therefore, Appellant does not understand how the Examiner can reasonably assert that the Declaration, incorporating the survey, as set forth in §2 of the Declaration, does not sufficiently address the specific claims.

As discussed in §5 of Mr. Domashnev's Declaration, "[t]here is an unfulfilled need in the electronic prescription industry to provide a system and method for providing a physician with authenticated access to generate a prescription from any Internet-connected computer, whereby a patient for whom the prescription is written invites bidding on his or her prescription in order to realize cost savings over market-priced drugs in the context of multi-objective prescription choices." This assertion is supported not only by the lack of an anticipatory reference disclosing all of the claimed elements of such a system and method, but also by a survey conducted by Mr. Domashnev of various physicians. Specifically, the survey consisted of the Survey Card being mailed to at least 500 physicians in the Pittsburgh, PA area. The attached Survey Card asked if the physician was interested in:

"an automated prescription process that might save you time and effort and provide you with great flexibility"

"a system that, if need be, would allow you to write prescriptions from anywhere in the world"

"a system that would allow you to lookup all available medications and their uses before prescribing medication to a patient"

"a system that would print out information on all available medications including available forms, possible side effects, past uses for treatments, etc."

"a system that would allow you to automatically send the prescription to an online prescription auction site that would find the best price for the prescription for your patient"

Another question that was asked was: "If the automated prescription process had the above functionality, would you use it?" to which the majority of responding physicians answered "yes," which leads to the conclusion that the majority of physicians indicated that they would be interested in the present invention (*See* §2 of the Declaration). Additionally, the majority of physicians indicated that they would pay a monthly fee for such a system. Specifically, about 15% indicated that they would pay \$200 a year for use of such a system, about 68% indicated that they would pay \$20 a month for use of such a system, and about 15% indicated that they would pay \$50 a month for use of such a system.

When undertaking an obviousness analysis, the Examiner is also required to take into account secondary considerations, such as long-felt need, for the applicant's invention. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Accordingly, the fact that the aforementioned survey questions were answered in the affirmative should be evidence of an existing long-felt need for the claimed electronic prescription handling system, which therefore weighs in favor of overcoming the Examiner's obviousness rejection. The Examiner has failed to take into account this secondary consideration in his obviousness analysis.

VIII. CLAIMS APPENDIX

Claim 1: An electronic prescription handling system comprising:

(a) a first computer configured to transmit a prescription by a physician;
(b) a server communicatively connected to the first computer and functionally distinct therefrom, wherein the server is configured to receive the prescription from the first computer, wherein the server is remote from the first computer and is operated by a service provider;

(c) a first pharmacy having a first pharmacy computer communicatively connected to the server, wherein the first pharmacy computer is configured to:

retrieve the prescription from the server; and

transmit a first bid for the prescription to the server, wherein the first bid is stored on the server;

(d) a second pharmacy having a second pharmacy computer communicatively connected to the server, wherein: the second pharmacy computer is configured to:

retrieve the prescription from the server; and

transmit a second bid for the prescription to the server, wherein the second bid is stored on the server; and

(e) a second computer communicatively connected to the server, wherein the second computer is operated by a patient and is configured to:

retrieve the first bid and the second bid; and

select one of (i) the first bid, and (ii) the second bid, such that when

the first bid is selected, the first pharmacy fills the prescription, and when the second bid is selected, the second pharmacy fills the prescription.

Claim 2: The electronic prescription handling system of claim 1, further comprising a portable storage medium configured to be interfaced with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate to the server when the portable storage medium interfaces with the first computer.

Claim 3: The electronic prescription handling system of claim 2, wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.

Claim 4: The electronic prescription handling system of claim 2, wherein the server is configured to authenticate the digital certificate.

Claim 5: The electronic prescription handling system of claim 4, wherein the server is further configured to transmit a prescription entry web page to the first computer upon the server authenticating the digital certificate.

Claim 6: The electronic prescription handling system of claim 5, wherein the server comprises:

a pharmaceutical database for storing a plurality of drug formularies therein;
and
a physician database utilized to authenticate the digital certificate.

Claim 7: The electronic prescription handling system of claim 6, wherein the server further comprises:

a prescription database for storing the prescription received from the first computer;
a patient database for storing patient information;
a pharmacy database for storing pharmacy data; and
a bid database for storing the first bid and the second bid.

Claim 8: The electronic prescription handling system of claim 7, wherein the patient information comprises at least one of (i) an insurance provider identifier for the patient, (ii) a medical history for the patient, (iii) a drug interaction list for the patient, and (iv) an allergic reaction list for the patient.

Claim 9: The electronic prescription handling system of claim 7, wherein the pharmacy data comprises contact information for one of (i) the first pharmacy and, (ii) the second pharmacy.

Claim 10: The electronic prescription handling system of claim 9, wherein the server is further configured to transmit at least one of (i) an address of the first pharmacy or second pharmacy, and (ii) a set of directions from the first pharmacy or second pharmacy to an address specified by the second computer.

Claim 11: The electronic prescription handling system of claim 10, wherein the server is further configured to transmit a map illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy.

Claim 12: The electronic prescription handling system of claim 1, wherein the first pharmacy is one of a brick-and-mortar pharmacy and an online pharmacy.

Claim 13: A method for issuing a prescription, the method comprising the steps of:

transmitting a prescription from a first computer by a physician;

receiving the prescription on a server functionally distinct from the first computer, wherein the server is remote from the first computer and is operated by a service provider;

retrieving the prescription from the server;

submitting a first bid for the prescription to the server from a first pharmacy having a first pharmacy computer;

submitting a second bid for the prescription to the server from a second

pharmacy having a second pharmacy computer;

storing the first bid and the second bid on the server;

transmitting the first bid and the second bid to a second computer operated by
a patient;

viewing the first bid and the second bid on the second computer;

making a selection consisting of one of (i) the first bid, and (ii) the second bid;

transmitting the selection to the server; and

informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the
prescription.

Claim 14: The method of claim 13, further comprising the steps of:
interfacing a portable storage medium with the first computer, wherein the
portable storage medium includes an application for transmitting a digital certificate; and
transmitting the digital certificate to the server.

Claim 15: The method of claim 14, further comprising the steps of:
authenticating the digital certificate on the server; and
transmitting a prescription entry web page to the first computer.

Claim 16: The method of claim 13, further comprising the steps of
transmitting to the second computer at least one of:

contact information of one of (i) the first pharmacy, and (ii) the second
pharmacy;

a set of directions from one of (i) the first pharmacy, and (ii) the second
pharmacy to an address specified by the second computer; and

a map illustrating an address on the map of one of (i) the first pharmacy, and
(ii) the second pharmacy.

Claim 17: An electronic prescription handling system comprising:
a computer;
a server communicatively connected to the computer;
a portable storage medium configured to interface with the computer;

an application residing on the portable storage medium, wherein the computer is configured to automatically execute the application once the portable storage medium interfaces with the computer, wherein the application includes a file associated therewith for instructing the computer to execute the application, further wherein the application is configured to transmit a digital certificate to the server upon the application sensing a network connection to the server; and

means for authenticating the digital certificate on the server, wherein when the digital certificate is positively authenticated, the server transmits a prescription entry web page to the computer, further wherein a user of the computer enters a prescription into the prescription entry web page, and thereafter the computer transmits the prescription to the server.

Claim 18: The electronic prescription handling system of claim 17, wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.

Claim 19: The electronic prescription handling system of claim 17, wherein the digital certificate identifies a physician.

Claim 20: The electronic prescription handling system of claim 18, wherein the digital certificate is hidden on the portable storage medium.

Claim 21: The electronic prescription handling system of claim 20, wherein the digital certificate cannot be copied from the portable storage medium.

Claim 22: The electronic prescription handling system of claim 19, wherein the server transmits the prescription to a pharmacy.

IX. EVIDENCE APPENDIX

Appendix A	Declaration Under 37 C.F.R. § 1.132
Appendix B	Survey Mailing

X. RELATED PROCEEDINGS APPENDIX

None

CONCLUSION


The present invention is a novel and non-obvious way for providing a lower cost prescription to a patient by inviting bids for the prescription and generating a prescription from an Internet-connected computer. The present invention is also a novel and non-obvious way for authenticated issuance of prescriptions from any Internet-connected computer. In view of the foregoing arguments, it is respectfully submitted that the rejections of claims 1, 10, 11, 13, and 17 under 35 U.S.C. §103(a) are improper. Accordingly, Appellant respectfully urges the Board to reverse the Examiner's final rejections of the claims and cause a Notice of Allowance to be issued.

Appellant hereby have paid the \$270.00 37 C.F.R. § 41.20(b)(2) small entity fee for filing an Appeal Brief Under 37 C.F.R. § 41.37. The Commissioner for Patents and Trademarks is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650.

Any questions regarding this submission should be directed to Appellant's undersigned representative, who can be reached by telephone at 412-471-8815.

Respectfully submitted,

THE WEBB LAW FIRM

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Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3600
Application No.: 10/773,912
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Attorney Docket No.: 4461-040040

APPENDIX A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/773,912 Confirmation No.: 7385
Applicant : Constantine A. DOMASHNEV
Filed : February 6, 2004
Title : **Electronic Prescription Handling System**
Group Art Unit : 3626
Examiner : Neal SEREBOFF
Customer No. : 28289

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.132

I, Constantine Domashnev, hereby declare as follows:

1. I am the named inventor of the invention described and claimed in the above-identified application entitled "Electronic Prescription Handling System", which was filed in the United States Patent and Trademark Office on February 6, 2004 and bears Serial No. 10/773,912.

2. As being the inventor, I am considered to be a person having ordinary skill in the art of ASP medical computing implementations. I have Master's degree in Math (Mathematical Cybernetics) and Master's degree in Industrial Administration (Operations Management and Automation). Around 2003 I have conceived and developed a prototype ASP which I believed should reduce the workload to everyone who handles medical prescriptions: Medical Doctors, Pharmacists, Recipients of, and Pharmaceutical Insurance Providers. I have conducted a small survey amongst local Medical Doctors and I have found that the critical group of potential users (Medical Doctors) would be interested in 2.a) using and 2.b) paying for my system. I also have an understanding of the teachings in United States Patent Application Publication 2002/0052760 to Munoz et al. (hereinafter "the Munoz publication") and United States Patent Application Publication 2003/0195838 to Henley (hereinafter "the Henley publication").

3. After review of the Munoz and Henley publications, I do not view either reference to contain any suggestion or motivation for one skilled in the art of ASP

medical-based computing implementations to utilize the teachings of either the Munoz or Henley publication in the context of an electronic prescription handling system according to the present invention. I make this statement based on the fact that:

(a) The deficiency of the system disclosed in the Munoz publication, among other things, lies in the fact that physicians are charged with the task of collecting, reviewing, and forwarding the bids to the patient, in paper form, nonetheless. In practice, the physicians will not have time to review all the bids and the workload will be increased for them. This, in effect, increases the cost of the prescription (i.e., increased overhead costs need to be passed on to the patient), which is opposite to the intended goal of the present invention. The service provider of the present invention undertakes this aforementioned increased overhead. Specifically, the patient is allowed to view and select from the offered bids via their own computer. The physician's duties therefore only extend to submission of the prescription, which is no different or incurs greater effort and resources, than is currently employed by a physician. It is more effective to allow the patient to view and select from the various bids because multiple criteria is to be taken into account. The patient's decision will be based, among other things, on geographic location, proximity to commuting routes, immediate availability, discount cards with some specific pharmacies, etc. It is not a single criteria choice (i.e., cost), as discussed in the Munoz publication. For example, if the cost of the medication was the only criteria, all patients would drive to Canada for their prescriptions. However, the cost of gas and time budgeting are part of the equation, as well; and

(b) In a simplistic view, the present invention may be termed to be a reverse auction. In the Henley publication, there is a disclosure with respect to "registered buyers" (e.g., patients) who have the ability to log-in to a computer system using their own computer for purposes of buying prescriptions at offered prices set forth by vendors. However, this disclosure in the Henley publication is akin to a traditional auction, as opposed to the reverse auction of the present invention. This assertion is supported by the fact that "registered buyers" in the Henley system can outbid other "registered buyers". However, the present invention is more than just a reverse auction in that a user (i.e., the patient) of the service is provided with multiple choices and trade-offs with respect to formulating a decision as to which pharmacy to utilize in filling the prescription. For example, convenience of picking up the medication and availability of the medication are factors which may cause the user to select a more expensive bid. Neither the Munoz nor Henley publications, either alone or in combination, disclose, teach, or suggest an ASP-based electronic prescription handling system comprising an auction conducive to multi-objective prescription choices offered to a patient.

4. The "Auto-run" feature of Microsoft Windows operating system can utilize a script file "autorun.inf" that is found on a portable storage medium that is recognized by the operating system, which in turn causes the associated executable file to run (see <http://en.wikipedia.org/wiki/Autorun>). In other words, the computer on which the storage medium is to be loaded automatically executes the application on the storage medium once the storage medium interfaces with the computer. This is accomplished by having an

Response Under 37 CFR 1.116

Expedited Procedure

Examining Group 3600

Application No.: 10/773,912

Paper Dated: June 5, 2008

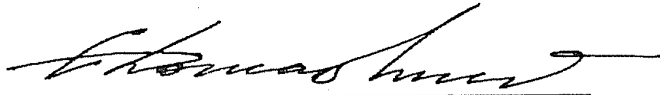
In Reply to: USPTO Office Action dated February 2, 2008

Attorney Docket No.: 4461-040040

application on the storage medium include a file associated therewith (e.g., autorun.inf) for instructing the computer to execute the application.

5. There is an unfulfilled need in the electronic prescription industry to provide a system and method for providing a physician with authenticated access to generate a prescription from any Internet-connected computer, whereby a patient for whom the prescription is written invites bidding on his or her prescription in order to realize cost savings over market-priced drugs in the context of multi-objective prescription choices.

6. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

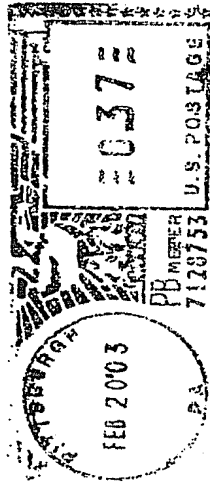


Constantine Domashnev

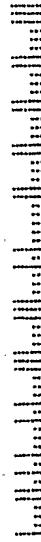
July 03, 2008

APPENDIX B

3261



Electronic Intellect Survey
P.O. Box 81911
Pittsburgh, PA 15217



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1. What part of the country do you live and work in?
- ☐ North Western United States ☐ Mid Western United States ☐ South Eastern United States
- ☐ South Western United States ☒ North Eastern United States ☐ Southern United States

2. Where do you practice medicine?
- ☐ Private practice ☐ Clinic ☐ Hospital ☐ Private industry

3. How many doctors currently work at your location?
- ☐ 1 ☐ 2 to 5 ☐ 6 to 20 ☒ greater than 100

4. How many prescriptions do you write on average in a day?
- ☐ None ☐ 1 to 3 ☒ 4 to 7 ☐ Greater than 12

5. Are you interested in an automated prescription process that might save you time and effort and provide you with great flexibility?
- ☒ Yes ☐ No

6. If so, would you be interested in a system that, if need be, would allow you to write prescriptions from anywhere in the world?
- ☒ Yes ☐ No

7. If so, would you be interested in a system that would allow you to look up all available medications and their uses before prescribing medication to a patient?
- ☒ Yes ☐ No

8. If so, would you be interested in a system that would print out information on all available medications including available forms, possible side effects, past uses for treatments, etc.?
- ☒ Yes ☐ No

9. If so, would you be interested in a system that would allow you to automatically send the prescription to an online prescription auction site that would find the best price for the prescription for your patient?
- ☒ Yes ☐ No

10. If the automated prescription process had the above functionality, would you use it?
- ☒ Yes ☐ No

11. What would you be willing to pay for the added information, convenience, flexibility and time-savings this system would provide?
- ☐ Would not use it ☐ \$50 per month ☐ \$500 per year ☒ \$20 per month